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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,692	09/26/2003	Satoshi Hiratsuka	YAMA-0059	9284
37013 7590 12/02/2011 Rossi, Kimms & McDowell LLP 20609 Gordon Park Square Suite 150 Ashburn, VA 20147				
			EXAMINER WILLIAMS, JEFFERY L.	
			ART UNIT 2437	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mail@rkmllp.com

Office Action Summary**Application No.**

10/672,692

Applicant(s)

HIRATSUKA, SATOSHI

Examiner

JEFFERY WILLIAMS

Art Unit

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1, 4-6, 8, 9, and 11-16 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1, 4-6, 8, 9, and 11-16 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☒ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-CB00)
Paper No(s) Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s) Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

This action is in response to the communication filed on 11/14/11.
All objections and rejections not set forth below have been withdrawn.
Claims 1, 4 – 6, 8, 9, and 11 – 16 are pending.

Priority

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification fails to provide proper antecedent basis for the recitations the amendment of 7/19/11 for a "terminal controller that sends to the contents supplying server apparatus a permission request..." (e.g. see claim 1; and essentially similar recitations found within claims 9, 15).

Regarding the applicant's added recitation of a "terminal controller", the examiner respectfully notes that applicant's originally filed specification disclosed separate and distinct elements of a "sending section" (e.g. see original claims 1 and 6), a "receiving section" (e.g. see original claims 1 and 6; also see present claim 6), and a "terminal controlling section" (e.g. see original claims 1 and 6). Analysis of applicant's originally filed specification would suggest that the originally recited "sending section" and "receiving section" would correspond to applicant's disclosure of the terminal's communication interface, which is a system element adapted with portions to send and receive (e.g. see figure 1B:8). Furthermore, the originally recited "terminal controlling section" would clearly appear to correspond to the originally disclosed CPU within the terminal (e.g. see figure 1B:1).

However, at present, it appears the applicant is replacing each of the separate and distinct recitations of a "sending section" and "terminal controlling section" with the single recitation of "terminal controller". Applicant argues that, even though the term "terminal controller" does not appear within applicant's original disclosure, one of ordinary skill in the art would understand that the originally recited "sending section" is the equivalent to the originally recited "terminal controlling section". Furthermore, applicant argues that one of ordinary skill in the art would additionally recognize that each of the "sending section" and "terminal controlling section" are themselves equivalent to the disclosed "CPU 1", now recited within the claim as a "terminal controller" (e.g. see Remarks, 11/14/11, pg. 6).

However, applicant's explanation raises further question as to why then is the originally claimed "receiving section" not also asserted by the applicant to be the equivalent to the disclosed "CPU 1" (now recited as the "terminal controller")? Instead, the applicant continues to claim the "receiving section" as separate and distinct from the claimed "terminal controller" (e.g. see claim 6). The examiner respectfully notes that if one of ordinary skill in the art would have understood each of the originally recited "sending section" and "terminal controlling section" to be equivalent to the "terminal controller", then one of ordinary skill in the art would have also understood the recited "receiving section" to be equivalent to the "terminal controller".

Thus, the examiner respectfully maintains that clear support and basis for the amendment of 7/19/11, for replacing each of the recitations of a "sending section" and "terminal controlling section", but not the recitation of the "receiving section", with the single recitation of "terminal controller", appears to be lacking.

Claim Objections

Claim 6, it is objected to for comprising the incorrect status identifier of "Currently Amended". The examiner notes that there does not appear to be any amendments made to the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4 – 6, 8, 9, and 11 – 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the claim limitations in the application as filed (see above objection to the specification).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4 – 6, 8, 9, and 11 – 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, regarding claims 1, 6, 9, and 16, they are rejected as unclear as the amended recitation of a "terminal controller" is indeterminate in scope. Specifically, the examiner respectfully notes that applicant's originally filed specification disclosed

1 separate and distinct elements of a terminal, comprising a "sending section", a
2 "receiving section" and a "terminal controlling section" (e.g. see original claims 1 and 6).
3 While applicant argues that each of the "sending section" and "terminal controlling
4 section" would have been obviously interpreted as the presently recited "terminal
5 controller", the applicant fails to explain why the presently recited "receiving section"
6 would not also be obviously equated to the presently recited "terminal controller" (see
7 Remarks, 11/14/11, pg. 6). Thus, the examiner respectfully notes that the metes and
8 bounds of the newly recited "terminal controller" is indeterminate, as the applicant's
9 explanation and present claims appear inconsistent and the term "terminal controller" is
10 not found to be explained within the applicant's specification as originally filed.
11 Furthermore, in view of the applicant's present arguments, it is noted that term
12 "receiving section" (e.g. see claim 6) has been rendered indeterminate in scope.
13 Specifically, the recited "receiving section" (e.g. see original claims 1 and 6; also see
14 present claim 6), similar to the originally recited "sending section" (e.g. see original
15 claims 1 and 6), would logically have been understood by one of ordinary skill in the art
16 to correspond to applicant's disclosure of the terminal's communication interface (a
17 system element adapted with portions to send and receive - e.g. see figure 1B:8).
18 However, the applicant's present argument and accompanying claims appear
19 inexplicably present the notion that the recited "sending section" is to be interpreted to
20 be CPU, however, the recited "receiving section" should not be interpreted to be a CPU.

For the purpose of examination, including the application of prior art, the examiner interprets the claimed "terminal controller" and the "receiving section" to each correspond to the originally disclosed CPU within the terminal (e.g. Fig. 1B:1).

Depending claims are rejected by virtue of dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 – 6, 8, 9, and 11 – 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Nozaki et al., (Nozaki), US Patent Publication 2002/0036800 A1.

Regarding claim 1, Nozaki discloses:

A contents supplying server apparatus that supplies contents for downloading via a communication network (e.g. Nozaki, fig. 2:1; see also figs. 12 -14, par. 220-221); and a plurality of information processing terminals associated with a user, contents from the contents supplying server apparatus being downloadable to each

1 *information processing terminal from the contents supplying server apparatus via a*
2 *communication network* (e.g. Nozaki, fig. 2:2a, 2b, 3, 5, 6; par. 13,14, 40, 48 – herein
3 the Nozaki discloses the prior art feature of a user possessing a plurality of “information
4 processing terminals”, wherein the “information processing terminals” [e.g. Nozaki, 2:
5 2a, 2b] are each connected to “a communication network” and may be used to
6 download “contents” from a “contents supplying server apparatus”),
7 *wherein the contents supplying server apparatus comprises: a server storing*
8 *device storing, together with numerous contents, user information for the user,*
9 *including user ID information representing a plurality of information processing terminals*
10 *associated with the user and contents purchase information comprising contents ID*
11 *information and copy control data, wherein the copy control data includes a total*
12 *number of times the downloaded contents are allowed to be copied to an external*
13 *apparatus or recording medium* (e.g. Nozaki, fig. 3:8, see also fig. 13,14, par. 220,221 -
14 herein Nozaki discloses a server storing device for storing content, user id information,
15 and content purchase information; e.g. Nozaki, par. 113, 190, 212-215, see also, par.
16 63,73,80 – herein Nozaki discloses that the server apparatus is provided with copy
17 control data indicating the maximum allowed copies as dictated by a copyright holder);
18 *and a server controller that in response to a copy permission request from the*
19 *user via one of the information processing terminals: supplies the copy control data of*
20 *the user to the one information processing terminal* (e.g. Nozaki, par. 62, 63, 105-107,
21 113, 146, 147 – it is herein noted that Nozaki discloses that one of the information
22 processing terminals receives the copy control data), *and decrements the total number*

1 *of times the downloaded contents are allowed to be copied from any of the information*
2 *processing terminals associated with the user (e.g. Nozaki, par. 62, 63, 105-107, 113,*
3 *207, 212 – 213 – herein Nozaki discloses that the server's copy control data is amended*
4 *until it reaches zero, at which point the server must re-order),*

5 *wherein each of the information processing terminals comprises: a terminal*
6 *storing device that stores the downloaded contents from the contents supplying server*
7 *apparatus (e.g. Nozaki, fig. 4:21);*

8 *and a terminal controller that sends, via a communication interface, to the*
9 *contents supplying server apparatus a copy permission request (e.g. Nozaki, par. 77;*
10 *fig. 4:36, 28) for copying the downloaded contents to the external apparatus or*
11 *recording medium each time before the downloaded contents are to be copied to the*
12 *external apparatus or recording medium (e.g. Nozaki, par. 100, 113, 141; fig. 1).*

13 Herein, the examiner notes that the prior art anticipates the recited structure of a
14 "terminal controller", argued on record by the applicant to be a CPU (e.g. see Nozaki,
15 fig. 3:9). However, for the applicant's benefit, the examiner notes that Nozaki
16 anticipates such intended use recitation. Regarding the applicant's description of an
17 intended use for the "sending section", the examiner notes that Nozaki discloses a
18 "sending section" that can be used to make a "copy permission" request each time a
19 copy is to be made. Note, that Nozaki allows copyright holders or distribution servers to
20 limit the copy count at their discretion, such that a user would be required to request a
21 reuse information key before making a copy (e.g. Nozaki, par. 100, 113, 141; fig. 1; see
22 also par. 146).

Regarding claim 4, Nozaki discloses:
wherein said server storing device stores an initial value of the copy control data, contents by contents (e.g. Nozaki, par. 63).

Regarding claim 5, Nozaki discloses:
wherein said contents are music data (e.g. Nozaki, par. 28).

Regarding claims 6, 8, 9, 13, 15, and 16 they are program, method, and apparatus claims corresponding to claims 1, 4, and 5, and they are rejected, at least, for the same reasons. Furthermore regarding claims 6 and 15, Nozaki discloses:
a receiving section for receiving the copy control data of the downloaded contents to be copied to the external apparatus or recording medium from the contents supplying server apparatus (e.g. Nozaki, fig. 3:9; par. 78; fig. 4:30, 28);
the terminal controller also determines whether or not to copy the downloaded contents to the external apparatus or recording medium based on the received copy control data (e.g. Nozaki, fig. 4:35; par. 76).

Regarding claims 12 and 13, they recite wherein the external apparatus is an electronic musical instrument, however, the examiner notes that "the external apparatus" is not a required limitation of the claims. Therefore, though Nozaki discloses

an apparatus capable of reproducing musical notes or sounds (e.g. Nozaki, par. 44), it is not necessary to address this recitation.

The examiner respectfully suggests that the applicant explicitly limit the apparatus of claim 1 and the system of claim 6 as comprising the recited electronic musical instrument.

Regarding claim 14, the examiner notes that Nozaki discloses an apparatus capable of reproducing musical notes or sounds (e.g. Nozaki, par. 44).

Response to Arguments

Applicant's arguments filed 11/14/11 have been fully considered but they are not persuasive.

Applicant argues essentially that:

...Applicant again traverses this rejection essentially for the reasons stated in the last reply, namely that Nozaki does not disclose or teach at least the claimed feature (1)(B)(ii) and (2) outlined below.

...

Again, applicant notes that none of the passages relied upon by the examiner supports the examiner conclusion that Nozaki's copy count setting section (software) 22

manages the decrementing of the copy count each time the user copies the downloaded contents.

...

... Nozaki does not disclose anywhere that the server changes the count information or keeps track of copy count information or that the PC sends the count information to the server each time it copies the already downloaded music contents. The examiner has yet to controvert this with real supporting evidence.

...

(Remarks, pg. 6-8)

The examiner respectfully responds:

The examiner respectfully disagrees. The prior art clearly shows that the server comprises means to manage, including decrementing, the copy count and employs such means to decrement the copy count (e.g. Nozaki, fig. 3:22; par. 26, 212-213).

Applicant argues essentially that:

...

The examiner also asserts that Nozaki supports "the prerogative of the content provider to limit the copy permission to an individual copy, thus inciting the PC to request permission each time it requires a new copy," relying on paragraph 100, 113, 141, 146, and Fig. 1.

Again, none of the passages relied upon by the examiner supports the examiner conclusion. If the examiner so adamantly believes that Nozaki teaches claimed feature (1)(B)(ii) and (2) outlined above, the examiner should pinpoint exactly where and how Nozaki teaches these limitations.

In sum, the examiner has yet to provide any support for, having the user PC send a copy permission request each time a copy is made in Nozaki. As previously explained, there simply is no disclosure anywhere in Nozaki for having the PC send a copy permission request each time a copy is made. The reuse request is made by the PC only after it determines that the copy count remaining is zero. (Remarks, pg. 9)

The examiner respectfully responds:

The examiner respectfully disagrees. The prior art clearly supports the ability of the content provider to limit the copy permissions to an individual copy, thus inciting the PC to request permission each time it requires a new copy. There is no restriction whatsoever within the disclosure of Nozaki that requires a content provider to allow the PC more than one copy at a time (e.g. Nozaki, par. 100, 113, 141; fig. 1; see also par. 146). The examiner respectfully points out that if the applicant believes that Nozaki requires content providers to provide content users with more than an individual copy at a time, it would be the burden *of the applicant* to prove such.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

See Notice of References Cited.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFERY WILLIAMS whose telephone number is (571)272-7965. The examiner can normally be reached on 9:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Shiferaw can be reached on (571)272-3867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2437

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffery Williams/
Examiner, Art Unit 2437
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